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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,455	03/17/2004	Manfred Heisler	WAS 0627 PUS	4002

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EXAMINER

SORKIN, DAVID L

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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11/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/802,455	Applicant(s) HEISLER ET AL.	
	Examiner DAVID L. SORKIN	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 29 October 2008 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathur et al. (US 2003/0229175) in view of Schuster et al. (US 5,854,343). Regarding claim 1, Mathur ('175) discloses a continuous process for preparing HTV organopolysiloxane compositions (see [0016]-[0018]) having a viscosity measured at 25 degrees C of at least 500 Pa·s (see [0015]), comprising mixing and kneading organopolysiloxanes and fillers (see [0023]) in a first process stage in a kneading cascade having at least two kneading chamber which are arranged in series (see

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[0023]), each containing two kneading tools having parallel axes and capable of being driven in co-rotating directions (see [0023]) at least the first kneading chamber having a feed opening and the last chamber having a discharge opening, to provide a raw organopolysiloxane mixture, and directly feeding the raw organopolysiloxane mixture from the discharge opening into a second stage process stage wherein the raw mixture is kneaded and degassed in a reciprocating kneader (114) (see [0008], [0009] and [0036] and claim 2 of Mathur '175). The first stage kneading is not exactly as claimed in that the material is not expressly disclosed to pass "transverse" to the axis of the kneading tools. Schuster ('343) discloses a kneading cascade having at least two kneading chambers (2) which are arranged in series adjacent one another, each containing two kneading tools (3) having parallel axes and are capable of being driven in co-rotating or counter rotating directions, said chambers being connected to one another by means of openings (5) through which material passes in a direction transverse to the axes (4) of the kneading tools, at least the first kneading chambers having a feed opening (6) and the last chamber having a discharge opening (7), to provide an organopolysiloxane mixture (see drawing and abstract). It would have been obvious to one of ordinary skill in the art to have substituted the kneading cascade of Schuster ('343) for the first stage of Mathur ('175), because Schuster ('343) explains in col. 5, lines 32-37 that the kneading machine provide the benefit of controlling intensity and residence time. Regarding claim 2, the kneading cascade taught by Schuster ('343) comprises from 3 to 10 chambers (see drawing). Regarding claims 3 and 4, the kneading tools taught by Schuster ('343) comprise kneading blades, rollers or polygonal

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plates (see col. 5, lines 66-67). Regarding claims 5-7, temperature of the reciprocating kneader is regulated (see [0036]). Regarding claim 8, the filler content is from 5 to 80% (see [0026]). Regarding claim 9, silicas having specific surface area determined by BET method of at least 50 m²/g are used as fillers (see [0026]). Regarding claims 10 and 11, polydimethylsiloxanes in accordance with these claims are disclosed or suggested in [0016]-[0018] of Mathur ('175). Regarding claim 12, Schuster ('343) teaches adding organopolysiloxanes having a viscosity measured at 25 degrees C from 10 to 200 mPa·s (see col. 6, lines 54-67). Regarding claim 13, both references further teach prehydrophobicized filler. See paragraph [0004] of Mathur '175 "a treating agent is added to reduce silanol functional groups", [0019] of Mathur '175, [0036] of Mathur '175 "pretreated filler", and col. 4, line 17 of Schuster '343 "The fillers (2) are prehydrophobicized". Regarding claim 14, while it should be noted that Mathur ('175) involves some obvious typographic errors (as can be verified by looking at the parent application thereof) such as "2600C" instead of -260°C - -, Mathur ('175) [0027]-[0030] and Schuster ('343) col. 6, line 64 each disclose temperature being less than 280°C. Regarding claim 15, Mathur ('175) further discloses adding organopolysiloxane, untreated filler and hydrophobicizing agent to (see [0024]). Regarding claim 16, Mathur ('175) further discloses adding organopolysiloxane, untreated filler and structure improver (see [0024]). Regarding claim 17, as seen in Fig. 1 of Schuster ('343), the absence of an additive inlet in the last chamber, would have suggested that no structure improver is added to the last chamber.

Response to Arguments

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4. Applicant remarks that "The claims have been amended to recite that the product of the first stage is directly input into the reciprocating kneader" (emphasis in original).

However, the actual language of the claims merely requires that the mixture is discharged directly into the "a second process stage". The second process stage includes, among possibly other events, kneading and degassing in a reciprocating kneader. In other words, the claims are opening to the second processes stage comprising steps involving structures in addition to the reciprocating kneader, and is open to mixture entry these other structure before entering the reciprocating kneader.

5. Also, while the BPAI decision mentions that direct transfer is not required (page 3, lines 4-6), applicant does not attempt to explain how adding such a requirement would or would not alter the conclusion of obviousness.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID L. SORKIN whose telephone number is (571)272-1148. The examiner can normally be reached on Mon.-Fri. 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DAVID L. SORKIN/
Primary Examiner, Art Unit 1797